

REMARKS

This Request is responsive to the Office Action dated July 15, 2004. Claims 1-39 were pending in the application. In the Office Action, claims 1, 3, 4, 7-10, 22, 24, 26, 28, 30, 32, 34, 37 and 38 were rejected and claims 2, 5, 6, 11-21, 23, 25, 27, 29, 31, 33, 35, 36 and 39 were allowed. In this Request, no claims have been amended or canceled. Claims 1, 3, 4, 7-10, 22, 24, 26, 28, 30, 32, 34, 37 and 38 thus remain for consideration.

Applicant submits that claims 1, 3, 4, 7-10, 22, 24, 26, 28, 30, 32, 34, 37 and 38 are in condition for allowance and requests reconsideration and withdrawal of the rejections in light of the following remarks.

§103 Rejections

Claims 1, 3, 4, 7-10, 22, 24, 26, 28, 30, 32, 34, 37 and 38 were rejected under 35 U.S.C. §103(a) as being unpatentable over Rao et al. (U.S. Patent No. 5,790,704) in view of Kikuchi (U.S. patent No. 5,828,326).

At pages 3-4 of the present Office Action, the Examiner admitted that Rao does not teach “a transmission signal generating portion for adding a synchronous signal that includes at least either a horizontal synchronous signal, a vertical synchronous signal, or a sequential synchronous signal.”

The Examiner relied on Kikuchi to teach such a feature. However, it is submitted that the Kikuchi patent reference cannot be used as prior art to reject the claims of the present invention.

The Kikuchi patent and the present application are assigned to a common assignee, Sony Corporation. The Kikuchi patent issued on October 27, 1998, which is several days after the

October 6, 1998 filing date of the Japanese priority application (JP 10-283991). Since a certified English translation of the Japanese priority patent application is filed herewith, the rejection based on Kikuchi is necessarily a 103(a) rejection that is based on 35 U.S.C. 102(e).

Under the provisions of 35 U.S.C. 103(c), as amended on November 29, 1999, subject matter developed by another person, which qualifies as prior art only under one of more of subsections (e), (f) and (g) of 35 U.S.C. 102, shall not preclude patentability under §103 where the subject matter and the claimed invention were, at the time the invention was made, owned by the same person or subject to an obligation of assignment to the same person.

Accordingly, because Kikuchi is only available as prior art under 35 U.S.C. 102(e), the Kikuchi patent cannot be used as prior art in a rejection under 35 U.S.C. 103(a) and the 103 rejections of claims 1, 3, 4, 7-10, 22, 24, 26, 28, 30 and 32 based on Kikuchi must be withdrawn.

This is in response to the Examiner's Statement of Reasons for Allowance, which were included at pages 11-13 of the Office Action mailed July 15, 2004. To the extent the Examiner's Statement of Reasons for Allowance states, implies or is construed to mean that the claims are allowable over the prior art of record because the Examiner believes the claims should be interpreted to include one or more features or limitations not recited therein, Applicants attorney disagrees with such an interpretation. Moreover, it is Applicants contention that there is no particular limitation in the allowed claims that is more critical than any other. The issuance of the Examiner's Statement of Reasons for Allowance should not be construed as a surrender by Applicants of any subject matter. It is the intent of Applicants, by their attorney, to construe the allowed claims so as to cover the invention disclosed in the instant application and all equivalents to which the claimed invention is entitled.

Applicant submits that all of the claims now pending in the application are in condition for allowance, which action is earnestly solicited.

If any issues remain, or if the Examiner has any further suggestions, he/she is invited to call the undersigned at the telephone number provided below.

The Examiner is hereby authorized to charge any insufficient fees or credit any overpayment associated with the above-identified application to Deposit Account No. 50-0320.

The Examiner's consideration of this matter is gratefully acknowledged.

Respectfully submitted,

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